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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JORDI ALBORNOZ

Appeal 2009-012862
Application 10/759,966
Technology Center 3600

Before, JAMES D. THOMAS, ANTON W. FETTING and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellant claims a system and method of online banking, and more specifically to automatic online payments. (Specification 1:7-8).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method for providing automatic recurring online payments, the method comprising the steps of:
 - receiving, from a user, an automatic recurring online payment configuration that includes an amount and an interval for executing a plurality of automatic recurring payments;
 - determining that one of the automatic recurring payments is to be executed based on the automatic recurring online payment configuration;
 - in response to determining that the one automatic recurring payment is to be executed, sending a notification to the user to notify the user that the one automatic recurring payment is to be executed, the notification being sent to the user before the one automatic recurring payment is executed; and
 - determining whether or not to execute the one automatic recurring payment based on at least one of a response to the

notification received from the user and a lack of a response to the notification from the user within a specified period of time.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Ensel US 6,493,685 B1 Dec. 10, 2002

The following rejection is before us for review.

The Examiner rejected claims 1-20 under 35 U.S.C. § 102(b) as being anticipated by Ensel.

The Examiner rejected claims 1-9 under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner rejected claims 1-9 under 35 U.S.C. 101 because the claimed invention is directed to non- statutory subject matter.

ISSUE

Has Appellant shown that the Examiner erred in rejecting claims 1-20 on appeal as being unpatentable under 35 U.S.C. § 102(b) over Ensel on the grounds that when the user uses the “pay the bill” button included in an email to a customer with an associated bill, this constitutes an execution of an automatic recurring online payment?

Has Appellant shown that the Examiner erred in rejecting claims 1-20 on appeal as being unpatentable under 35 U.S.C. 112, second paragraph?

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Ensel discloses recurring or monthly presented bills for payment by a company, such as telephone or utility companies to which a user who owes money for service. (Col. 2, ll. 51-52).
2. Ensel discloses payment preference options which can be selected by a client including preauthorized, on due date, at end of month, full or fixed amount, automatic within limit. (col.10, ll. 41-45)
3. Ensel discloses:

[T]he IIP 20 formats the electronic bill, encrypts it and send the Email to the Email address previously provided by the customer 80. Once the Email message has arrived at the server containing the customer's Email account, the customer 80 is able to open the message, decrypt and review the bill. In one embodiment of the present invention, the mechanism for effecting the customer's payment is included in the Email message, for example code which creates a "pay the bill" type button. In one example, this button may link the customer to a biller direct site 35 or another CSP site (e.g., one maintained by the IIP 20) where the customer can pay the electronic bill.

(Col. 8, ll. 52-63).

4. The Examiner found that the claim limitation of *in response to determining that the one automatic recurring payment is to be executed, sending a notification to the user to notify the user that the one automatic recurring payment is to be executed, the notification being sent to the user before the one automatic recurring payment is executed* is disclosed by Ensel when an email containing the bill with a “pay the bill” button is included in the email, and is used or not used to pay the bill at that time. (Answer 13).

ANALYSIS

We affirm the rejection of claims 1-20.

Initially, we note that the Appellant argues independent claims 1, 10 and 17 together as a group. Correspondingly, we select representative claim 1 to decide the appeal of these claims, remaining claims 10 and 17 standing or falling with claim 1. Appellant does not provide a substantive argument as to the separate patentability of claims 2- 9, 11-16 and 18-20 that depend from claims 1, 10 and 17, respectively. Claims 2- 9, 11-16 and 18-20 thus fall with claims 1, 10 and 17. *See*, 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Preliminarily, we address the scope of the claims. Claim 1 recites, in pertinent part, “automatic recurring online payments”. We interpret this phrase to require only that payments be made automatically e.g., on line, and that such payments are recurring, e.g., payments to be made each month.

The Examiner found that the claim limitation, *in response to*

determining that the one automatic recurring payment is to be executed, sending a notification to the user to notify the user that the one automatic recurring payment is to be executed, the notification being sent to the user before the one automatic recurring payment is executed, is disclosed by Ensel when an email containing the bill with a “pay the bill” type button is included in the email and is or is not used to pay the bill at that time. (FF 4)

Appellant however argues that:

Ensel does not teach determining that an automatic recurring payment is about to be executed, notifying a user that the payment is about to be executed, and executing or not executing the automatic recurring payment based on the user's response or lack of response to the notification. Ensel merely teaches that a system transmits billing information to a user who then gives instructions on how to pay the bill. The system of Ensel then pays the bill based on the user's payment instructions. If the user sets up an automatic payment, the system of Ensel simply pays the bill automatically like any conventional bill payment system.

(Appeal Br. 8).

We disagree with Appellant because Appellant has adopted an overly narrow interpretation of the claim language in responding to the Examiner's rejection. We find rather that Ensel discloses recurring or monthly presented bills for recurring payment to a company, such as to telephone or utility companies (FF 1). That is, Ensel discloses recurring billing, which correspondingly means recurring payments are to be made by user in

response to such recurring billing. We find that in Ensel, emailed bills are sent to a user *before* the user uses the “pay the bill button” to make payment because the button is part of the same communication which initially presents the bill to the customer. (FF 3). We thus find that when the user executes payment using the “pay the bill” button, this constitutes an automatic payment of a recurring required payment. Accordingly, Ensel meets the required claim limitation.

Appellant argues next that:

...Ensel does not teach sending a notification to the user to notify the user that an automatic recurring payment is to be executed before that automatic recurring payment is executed. Therefore, Ensel cannot possibly teach determining whether or not to execute a payment based on a response to such a notification received from the user and/or a lack of a response to such a notification from the user within a specified period of time.

(Appeal Br. 12)

Claim 1 recites, in pertinent part, *determining whether or not to execute the one automatic recurring payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user within a specified period of time.*

Based on our reading of this claim language, we are again not persuaded by Appellant’s arguments because we do not interpret the claims to require that the recurring payment be automatic, but that execution of payment be automatic to a recurring obligation to pay. As found *supra*, the

user in Ensel by activating the “pay the bill” button, causes an automatic execution of a recurring payment. The IIP or the CSP being the recipient of the signal from an activated “pay the bill” button (FF 3), determines if the “pay bill” signal is present or not in order to effect payment or not effect payment. The default condition is a “no pay” mode where no pay bill signal is received from the button. We thus find that Ensel meets the determining step of claim 1.

We will not sustain the rejection of claims 1, 8 and 9 under 35 U.S.C. 112, second paragraph. The Examiner found that these method claims lacked definiteness because “Applicant's claimed limitations do not adequately describe the structure of the device. As such, it is necessary to clarify where the computer implementation takes place.” (Answer 3). We decline to accept this reasoning because it goes to patent eligibility rather than definiteness, which is covered under 35 U.S.C. § 101, and not 35 U.S.C. 112, second paragraph.

Since our decision finds that all the claims on appeal were rejected under 35 U.S.C. § 102(b) without error, we need not reach the rejection of claims 1-9 under 35 U.S.C. § 35 U.S.C. § 101.

CONCLUSIONS OF LAW

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 1-20 under 35 U.S.C. § 102(b) as being anticipated by Ensel.

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Application 10/759,966

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 1-9 under 35 U.S.C. 112, second paragraph.

DECISION

The decision of the Examiner to reject claims 1-20 is AFFIRMED.

AFFIRMED

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